Application No.: 10/821,389 Docket No.: 381092000624

## **REMARKS**

The claims have been amended in response to the outstanding rejections. Claim 1 has been limited to a method to treat pain, an indication that was already set forth in the claim, and is therefore supported. Claim 16 has been made independent and is also directed to a method to treat pain. Both claims 1 and 19 have been amended to correct an oversight wherein an inconsistency in the value of n was kindly noted by the Office. Thus, no new matter has been added and entry of the amendment is respectfully requested.

There is no remaining rejection over the art.

## The Rejection Under 35 U.S.C. § 112, Paragraph 1

This was applied to claims 1-5, 7 and 9-16, all of them directed to methods of treatment. Applicants appreciate the acknowledgement that the specification is clearly enabling for the treatment of pain as the success of these compounds has been demonstrated in an animal model. Such a demonstration has been held adequate to support enablement, for example, in *In re Brana*, 51 F3d 1650, 34 USPQ2d 1436 (Fed. Cir. 1995). Accordingly, this basis for rejection may be withdrawn.

## The Rejections Under 35 U.S.C. § 112, Paragraph 2

All claims were rejected because claims 1 and 19 had an inconsistency in the value of n. This has now been corrected.

The Office then objects that claims 16 and 19 name compounds that appear to have n=0, a value that is no longer present in claims 1 and 19. Claim 16 has been amended so that it no longer depends on claim 1 and thus the five compounds noted by the Office, where indeed, n is 0, are

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legitimately included in this claim. It appears that claim 29 was not, in fact, dependent from

claim 19 and thus should have been free of this rejection.

Conclusion

The Office is still correct that the prior art does not fairly suggest the compounds claimed or

their use. Accordingly, it is believed that the pending claims, claims 1-5, 7, 9-16 and 19-31, are in a

position for allowance and passage of these claims to issue is respectfully requested.

Should minor issues remain that might be resolved over the phone, a telephone call to the

undersigned is respectfully requested.

In the unlikely event that the transmittal letter is separated from this document and the Patent

Office determines that an extension and/or other relief is required, applicants petition for any

required relief including extensions of time and authorize the Commissioner to charge the cost of

such petitions and/or other fees due in connection with the filing of this document to **Deposit** 

Account No. 03-1952 referencing docket No. 381092000624.

Respectfully submitted,

Dated: June 23, 2008 By:

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